

REMARKS

Claims 1, 3, and 15 have been amended. Claims 77-85 have been added. Claims 1-85 remain in the application, although claims 23-32 and 49-5 76 have been withdrawn from consideration as a non-elected group. Further examination and reconsideration of the application, as amended, is hereby requested.

A petition for a two month extension of time accompanies this 10 Amendment.

In Section 4 of the Office Action, the Examiner rejected claims 1-3, 12-15, and 33 under 35 USC §103(a) as being unpatentable over Griebenow in view of Austin. Applicants have amended claims 1, 3, and 15 to further clarify 15 their invention over the Griebenow and Austin references.

As the Examiner states on the 8th line of Section 4 of the Office Action, "Griebenow discloses the document being automatically sent to the user, but does not explicitly disclose that the document will also be automatically 20 printed on the user's printing device." Therefore, the Examiner's statements on lines 3-7 of Section 4 are assumed to be typographical errors, since Griebenow can then clearly not "disclose a method for automatically printing a document", or "storing a print schedule". Instead, the Examiner relies on Austin for these teachings. More specifically, the Examiner relies on 4 lines of 25 text in the Austin reference that asserts that a document can be delivered directly to a user's printer. While Applicants note that the Austin reference contains no further specific teachings as to how this might actually be done, Applicants have amended claim 1 to clarify that the print schedule includes "an indication that the document should be printed at a user requested time". 30 Support for this amendment can be found at Page 7, line 30 of Applicants' specification, as well as Fig. 7 and Fig. 8.

The Austin reference does not disclose, teach, or suggest any type of schedule for delivering any information, let alone a "print schedule" which

includes “an indication that the document should be printed at a user requested time”, as Applicants are claiming. As mentioned previously, Griebenow also fails to teach anything about printing so cannot then teach a “print schedule”. Column 8, lines 19-27 in Griebenow states that “timing engine 50 will cause events to be generated each month when the electronic publication is ready for delivery”. This type of scheduling was contemplated by the Applicants on page 7, line 30 of the Specification (“upon document creation”), but does not disclose, teach or suggest a print schedule that includes “an indication that the document should be printed at a user requested time”, as Applicants are claiming. Therefore, claim 1 as amended, and all subsequent dependent claims, are deemed patentable over the art of record.

In addition, a subset of these dependent claims contain additional limitations that form an independent basis of patentability over Griebenow and Austin. For example, claim 3 claims the following additional limitation: “responsive to causing printing of the document on the printing device, updating the user profile.” Applicants have further amended claim 3 to clarify that the user profile is updated “with an indication that the document printed successfully.” Support for this amendment can be found on page 9, lines 11-20, and Fig 7. Neither Griebenow or Austin, taken alone or together, disclose, teach, or suggest, “responsive to causing printing of the document on the printing device, updating the user profile with an indication that the document printed successfully”, as Applicants are now claiming.

Newly added independent claim 77 is similar to amended claim 3, but does not include the limitation that the print schedule includes “an indication that the document should be printed at a user requested time”. This limitation is included in dependent claim 78. Dependent claims 79 and 80 provide further limitations that the “user requested time” is “a specific day of the week or month” and “the lapse of a user specified time period”. Support for these amendments can be found on Page 7, lines 28-31, and Fig 8. Claims 1-22, 33, and 77-80 are believed patentable over the art of record.

In Section 5 of the Office Action, the Examiner rejected claims 34-38 and 43-48 under 35 USC 103(a) over Logan. Applicants respectfully traverse

this rejection. Applicant agrees with the Examiner that "Logan discloses monitoring the usage of an audio device instead of a printing device", but disagrees that it would have been obvious to one of ordinary skill in the art reading the Logan reference to "monitor the usage of a printing device", as 5 Applicants are claiming. Applicants respectfully submit that the Examiner is improperly using hindsight gleaned from his knowledge of Applicants' teachings to find motivations in Logan to practice Applicants' invention. Logan's briefly mentions sending downloaded text files to his audio device, but this is completely insufficient to form a basis for suggesting that Logan 10 teaches the ability to "monitor the usage of a printing device", as Applicants are claiming. Therefore, claim 34, as well as its dependent claims, are deemed patentable over the art of record.

Applicants also strongly disagree with the Examiner's rejections of claims 35-38, based on his assertion that Logan discloses "updating a user profile...with the amount of resources (e.g., ink, paper, etc.) [t]hat has been used to print the document" As support for this assertion, the Examiner cites 15 col 26, lines 53-59 of Logan, which states the following: "Subscriber billing is based on the accumulated amount of programming actually played by the subscriber with credit being given for advertising actually presented to the 20 subscriber. To accomplish this, a detailed billing history can be constructed from the usage log which indicates the programs heard, the duration of each, and the cost (or credit) attributable to the program segment". There is clearly nothing in this cited passage that has anything to do with printing, let 25 alone "updating a user profile to indicate that a document has been printed for a user" (claim 35); "the updating step indicates that advertising in the document has been printed" (claim 36); "updating a user profile to indicate the amount of ink that was used when a document was printed" (claim 37); or "updating the user profile to indicate the amount of each of a plurality of different colored ink that was used when a document was printed" (claim 38). 30 Applicants believe the rejections of these claims over Logan are improper and should be withdrawn.

New independent claim 81 is similar to claim 34, but includes the limitation that "a product that is depleted upon the usage of the printing

device" is subsidized. Support for this claim can be found on Page 10, line 13. Dependent claims 82 claims that the "product in the subsidizing step is mailed to the user". Support for this claim can be found on Page 11, lines 1-3. Dependent claim 83 claims "a coupon for the product in the subsidizing step is sent to the user." Support for this claim can be found on Page 11, lines 4-5. Dependent claim 84 claims that "the product in the subsidizing step is a print consumable". Support for this claim can be found on Page 10, line 10. Dependent claim 85 claims that "the product in the subsidizing step is printable media.". Support for this claim can be found on Page 10, line 26. Claims 81-85 are deemed patentable over the art of record.

In Section 6 of the Office Action, the Examiner rejected claims 4-11, 16-22, and 39-42 under 35 USC 103(a) over Griebenow in view of Austin in further view of Logan. Applicants have already discussed above that the claims that depend on independent claim 1 (as amended) and claim 34 are patentable over the art of record. In addition, Applicants respectfully disagree with the Examiner's assertions that "all three references further disclose sending... promotional products." While at least some of these references do disclose sending advertising, Applicants could not find any disclosure, teaching or suggestion in any of these references that the *products themselves*, such as Applicants' claimed "print consumable", "printable media", or "printing device", are sent to users. Again, Applicants believe that the Examiner is improperly using hindsight gleaned from his knowledge of Applicants invention in forming a basis for this rejection.

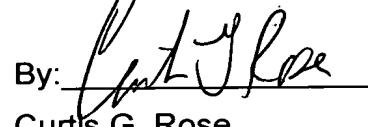
Applicants believe their claims as amended are patentable over the art of record, and that the amendments made herein are within the scope of a search properly conducted under the provisions of MPEP 904.02.

5 Accordingly, claims 1-22, 33-48, and 77-85 are deemed to be in condition for allowance, and such allowance is respectfully requested.

Respectfully Submitted,

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